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| 10/763,284 | 01/26/2004 | Tomohiro Shinoda | KAW-314-USAP | 6476 |
| 28892 7590 03/21/2007 SNIDER & ASSOCIATES P. O. BOX 27613 WASHINGTON, DC 20038-7613 | | | EXAMINER LEE, BENJAMIN WILLIAM | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3714 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/763,284 | Applicant(s) SHINODA, TOMOHIRO | |
| | Examiner Benjamin W. Lee | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on 01/29/2007 has been entered.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 5, 13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (US 6,468,162 B1).

Re claim 1: Nakamura discloses a gaming machine for providing a game played with a trading card (72) which stores character data of a character and has a surface printed with a detail of the character data. Nakamura further discloses the gaming machine comprises a data updating device/printer (56) that writes changed character data in the trading card in response to a change in the character data according to a state of proceeding with the game. The changed character data is written and stored on the surface of the trading card and the character data changes according to a state of proceeding with the game (see Figs. 11A and 11B). Nakamura further discloses the gaming machine comprises a printing device (56) that prints a detail of the changed character data onto the surface of the trading card (see Figs. 2, 3A, 7, 11A, and 11B; col. 5, lines 51-58; col. 12, line 53 - col. 13, line 17).

Re claim 5: The teachings of Nakamura as applied to claim 1 have been discussed above. Nakamura further discloses a plurality of gaming machines arranged in parallel (see Fig. 1). The arcade game machines 10-1, 10-2, ... , 10-N are networked to a host machine. Each arcade machine may perform their respective operations simultaneously (in parallel).

Re claim 13: Nakamura discloses a game system comprising a trading card (72) which stores character data of a character and has a surface printed with a detail of the character data; a game controlling device/processing section (20) which proceeds with a game according to the character data stored in the trading card and a control signal from a controller (64); a data updating device (56) which writes changed character data in the trading card in response to a change in the character data according to a state of proceeding with the game (see Figs. 11A and 11B); and a printing device (56) which prints a detail of the changed character data onto the surface of the trading card (see Figs. 2, 3A and 7; 11A, and 11B; col. 5, lines 51-58; col. 12, line 53 - col. 13, line 17).

Re claim 17: The teachings of Nakamura as applied to claim 13 have been discussed above. Nakamura further discloses a plurality of gaming machines arranged in parallel (see Fig. 1). The arcade game machines 10-1, 10-2, ... , 10-N are networked to a host machine. Each arcade machine may perform their respective operations simultaneously (in parallel).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 2-4 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Takemoto (US 5,534,685).

Re claims 2-4: The teachings of Nakamura as applied to claim 1 have been discussed above.

However, Nakamura fails to disclose or fairly suggest an erasing device which erases the detail of the character data printed previously when the printing device prints the detail of the changed character data on to the surface of the trading card, the printing device is utilized so as to add the detail of the changed character data to the detail of the character data printed previously, and a trading card moving device having a slot which inserts and discharges the trading card, the trading card moving device moving the trading card inserted in the slot into the gaming machine.

Takemoto et al. teaches a repeatedly usable recording medium card and a recording medium card processor for use in gaming machines. The recording medium card processor features an erasing mechanism (35) which erases the detail of data printed previously when the recording medium card processor prints the detail of changed data on to the surface of the card (see Fig. 2; col. 7, lines 35-43). Takemoto et al. further discloses the recording medium processor is used to visually record and erase necessary items (see col. 2, lines 50-58).

Art Unit: 3714

Takemoto et al. further discloses that the recording medium card processor has a slot (31, 56), inserts and discharges the card, and moves the card inserted in the slot into the gaming machine (see col. 7, lines 12-26).

Therefore, in view of Takemoto et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the printer of Nakamura with the recording medium card processor of Takemoto et al. in order to prevent the waste of natural resources by saving paper.

6. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta et al. (US 2004/0169086 A1) in view of Kazushi (Japanese Unexamined Patent Publication No. HEI 8-80682).

Re claims 10-12: Ohta et al. discloses an IC card (see Fig. 1) which stores character data of a character and has a surface/reversible recording layer (3) printed with a detail of the character data. The detail of the character data is printable a plurality of times on the reversible recording layer (see ¶ [0004], lines 1-4; ¶ [0074]). Ohta et al. further discloses the card comprises an antenna/circuit pattern (12) and a single chip (14) which allows a radio wave to be transmitted and received (see Figs. 12 and 14; ¶ [0004]; ¶ [0041]), a rewritable layer (3) adapted to become transparent or opaque depending on heat (see ¶ [0006]), the rewritable layer becomes transparent when heated to a specific temperature so that the detail of the character data printed on the surface is erased (see ¶ [0006]; ¶ [0077], lines 10-15), and the rewritable layer selectively

Art Unit: 3714

becomes opaque so that the detail of the character data appears on the trading card and is printed (see ¶ [0006]).

However, Ohta et al. fails to disclose or fairly suggest a color layer which generates heat upon irradiation with the light having a specific wavelength.

Kazushi teaches a color rewritable recording medium and recording method using the same. As admitted by the Applicant, Kazushi discloses the printing and erasing processes concerning the rewritable card, including a color layer and a rewritable layer.

Therefore, in view of Kazushi, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the color rewritable techniques of Kazushi in the IC card of Ohta et al. in order to provide rewritable color printing which would increase the aesthetic appeal of the IC cards.

7. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Ohta et al.

Re claims 18: The claim limitations “updating means for writing changed character data in the trading card in response to a change in the character data according to a state of proceeding with the game” on lines 5-7 and “printing means for printing a detail of the changed character data onto the surface of the trading card” on lines 8-9 invoke 35 U.S.C. 112, sixth paragraph.

Nakamura discloses a printer (56) which prints a detail of the changed character data onto the surface of the trading card.

However, Nakamura fails to disclose or fairly suggest an updating means for writing changed character data in the trading card in response to a change in the character data according to a state of proceeding with the game.

Ohta et al. teaches an IC card and a reader/writer for communicating with the IC card which is equivalent to the controller 40 and R/W 50 as depicted in Fig. 4B (see ¶ [0154]).

Therefore, in view of Ohta et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the IC card and reader/writer Ohta et al. in place of the memory card and trading card of Nakamura in order to increase the security of the card game by making forgery of cards more difficult.

Re claim 19: The claim limitation “erasing means for erasing the detail of the character data printed previously when the printing means prints the detail of the changed character data onto the surface of the trading card” on lines 1-4 invokes 35 U.S.C. 112, sixth paragraph.

The teachings of Nakamura in view of Ohta et al. as applied to claim 18 have been discussed above. Ohta et al. further discloses a reversible recording layer (3) that becomes transparent or opaque depending on heat (see ¶ [0006]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add an erasing/printing device adapted to take advantage of the reversible recording layer of the IC card.

Re claim 20: The claim limitations “game controlling means for proceeding with a game according to the character data stored in the trading card and a control signal from a controller” on lines 4-5, “updating means for writing changed character data in the trading card in response

Art Unit: 3714

to a change in the character data according to a state of proceeding with the game” on lines 6-8, and “printing means for printing a detail of the changed character data onto the surface of the trading card” on lines 9-10 invoke 35 U.S.C. 112, sixth paragraph.

Nakamura discloses a trading card (72) which stores character data of a character and which has a surface printed with a detail of the character data, a processing section (20) that is equivalent to the main controller 30 as depicted in Fig. 4A, and a printer (56) for printing a detail of the changed character data onto the surface of the trading card (see Figs. 2 and 7; col. 5, lines 59-67; col. 7, lines 56-60).

However, Nakamura fails to disclose or fairly suggest an updating means for writing changed character data in the trading card and a control signal from a controller.

Ohta et al. teaches an IC card with an IC chip and a reader/writer to communicate with the IC card (see ¶ [0004]; ¶ [0154]).

Therefore, in view of Ohta et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the IC card and reader/writer Ohta et al. in place of the memory card and trading card of Nakamura in order to increase the security of the card game by making forgery of cards more difficult.

Response to Amendment

8. It has been noted that the specification and claims have been amended. Claims 6-9 have been cancelled. Claims 1, 5, 10, and 16-18 have been amended. Claims 1-5 and 10-20 are pending in the application.

Response to Arguments

9. Applicant's arguments filed 01/29/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "trading card memory" on page 16 of applicant's amendment) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claim 1, there is no limitation that requires "trading card memory." The claim has the limitations "trading card which stores character data of a character" and "data updating device which writes changed character data in the trading card in response to a change in the character data according to a state of proceeding with the game." While these limitations may be interpreted to mean that the applicant's invention implicitly requires the trading card to have memory, such as an integrated circuit (IC) memory, the limitations may be interpreted alternatively. The printed matter on the face of the trading card of Nakamura stores character data ("trading card which stores character data"). In addition to being a "printing device," the printer (56) of Nakamura may also be considered a "data updating device" because it prints/writes changed character data to the trading card (see Fig. 7; col. 11, lines 47-53).

Regarding claim 5, the examiner notes that the claim recites the limitation "wherein at least one of the gaming machines comprises" a data updating device and a printing device. Furthermore, the claim requires that the gaming machines be arranged in "parallel," which the

examiner interpreted to mean either the physical arrangement of the machines are in parallel or the network architecture of the gaming machines are in parallel. Nakamura discloses the latter of the interpretations. Fig. 1 of Nakamura shows a plurality of gaming machines communicating with a host machine and operating independently and concurrently of each other. Therefore, the gaming machines of Nakamura in Fig. 1 are considered to be arranged in "parallel."

Regarding claim 13, the examiner has previously discussed the unclaimed feature of "trading card memory" as applied to claim 1.

Regarding claim 17, the examiner has previously discussed the unclaimed feature of "trading card memory" as applied to claim 1. In response to the applicant's argument that Nakamura does not respond to the last paragraph of claim 17, the examiner respectfully disagrees. Nakamura discloses a printer 56, which prints a detail of the changed character data onto the surface of the trading card (see Figs. 11A and 11B; col. 12, line 53 - col. 13, line 17).

In response to applicant's argument that there is no suggestion to combine the references (regarding claims 2-4 and 14-16), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Takemoto discloses the motivation of using reprintable cards for in order to avoid wasting resources (see col. 2, lines 15-21). The examiner also respectfully disagrees with the applicant that "players are not interested in waste of natural resources and neither are owners of gaming machines." Operators of the gaming machines would be interested

Art Unit: 3714

decreasing the amount of rubbish and it is well known in the art that there are many people who recycle because they are mindful of wasting natural resources.

In response to applicant's argument that Ohta and Kazushi are nonanalogous art (regarding claims 10-12), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Ohta reference is reasonably similar to the problem the applicant is concerned (a rewritable card with IC memory). The examiner also takes the position that since Ohta discloses a reversible (rewritable) display layer, it would be reasonable to combine Ohta with the Kazushi reference since the Kazushi reference discloses a process for color rewritable cards. In response to the applicant's argument that there is no suggestion or reason to combine Ohta and Kazushi, the examiner takes the position that it was well known in the art at the time the applicant's invention was made to use color printing processes in order to make printed material more attractive and appealing to readers.

In response to the applicant's argument that there is no motivation to combine Ohta and Nakamura in either reference (regarding claims 18-20), the examiner respectfully disagrees. The examiner agrees that the card of Nakamura does not have IC memory. The card of Ohta has both a rewritable surface and IC memory. Ohta discloses that the use of an IC chip incorporated into the substrate of a card increases security because the information may be stored in coded form (see ¶ [0002]).

Regarding claim 19, the applicant argues that the examiner does not explain why it would be obvious to modify the fundamental operation of Nakamura to provide printing and erasing. The examiner takes the position that it would have been obvious to modify Nakamura to have reversible printing and erasing with the card of Ohta since Nakamura since the characters printed on the cards of Nakamura are saved on a storage device (see Fig. 10). Thus, it is possible for cards featuring the same character to be printed, but with different characteristics. The IC card of Ohta features a rewritable card surface for displaying information corresponding to the data stored in the IC memory (see ¶ [0005] - ¶ [0006]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the IC card of Ohta with the gaming machine of Nakamura.

Regarding claim 20, the applicant argues that the examiner that Ohta does not teach or suggest means similar to those shown in applicant's Figures 2 and 3 (because the applicant invokes 35 U.S.C. 112). The examiner respectfully disagrees. In the applicant's specification, the applicant states "the controller 40 and R/W 50 function as updating means" (¶ [0108]) and "the controller 40 and printing device 49 function as printing means" (¶ [0110]). Figures 2 and 3 of applicant's specification disclose more than controller 40, R/W 50, and printing device 49, and contradicts the applicant's definition of the aforementioned elements as the "updating means" and "printing means." The examiner maintains the position that reader/writer of Ohta is an equivalent structure to the applicant's "updating means" and "printing means."

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sanada et al. discloses a non-contact IC card with a reversible information display.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin W. Lee whose telephone number is 571-270-1346. The examiner can normally be reached on Mon - Thurs (8:30AM-6PM), or Alt. Fri (8:30AM-5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

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bwl/
Benjamin W. Lee
March 5, 2007



KIM NGUYEN
PRIMARY EXAMINER